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NO.

IN THE
SUPREME COURT OF THE UNITED STATES

OCTOBER TERM 1986

JOSEPH O. OBIAYA, PETITIONER
v. BABCOCK & WILCOX CO., ET AL.

PETITION FOR WRIT OF CERTIORARI TO

THE UNITED STATES COURT OF APPEALS

FOR THE FEDERAL CIRCUIT

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Petitioner
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Warrensville Heights, OH 44128

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QUESTIONS PRESENTED FOR REVIEW

1. Is the Court of Appeals' interpretation of a skilled artisan under 35 USC §103 as a nonentity valid?

2. Did the Court of Appeals overreach the provisions mandated by the Supreme Court decision of Graham v. Deere?

3. Can the Court of Appeals' determination of nonpatentability that is based upon the teaching of prior art references be sustained, under 35 USC §103, even though a team of skilled artisans, who were faimilar with the teachings of the same references, failed in prior efforts to develop the invention?

4. Does failure by others as described in 3 above deserve "primary"

or "secondary" consideration in the determination of nonobviousness?

5. Is the Obiaya '458 patent obvious or nonobvious?

PARTIES TO THE PROCEEDINGS

1. Commissioner of the Patent and Trademark Office

2. Babcock & Wilcox Parent Company, Requester of patent reexamination.

a) Bailey Controls Company, a Division of Babcock & Wilcox (formerly Bailey Meter Company, a subsidiary of Babcock & Wilcox).

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OPINIONS DELIVERED IN THE COURT OF APPEALS AND UNITED STATES PATENT AND TRADEMARK OFFICE

1. Patent and Trademark Office Board of Appeals and Interferences Decision of July 23, 1985, 227 USPQ 59 (1985).

2. United States Court of Appeals for the Federal Circuit decision of May 30, 1986 (Unpublished).

STATEMENT OF THE GROUNDS ON WHICH THE JURISDICTION OF THIS COURT IS INVOKED

This is a petition for Writ of Certiorari following judgment on the reexamination of U.S. Patent No. 4,128,458 by the United States Court of Appeals for the Federal Circuit (Referred to henceforth as the Court of Appeals) on May 30, 1986. Jurisdiction

is conferred on this Court by 28 USC 1254 §1

The Court of Appeals decided an important question of federal law which has not been, but should be, settled by this Court. In the process, it failed to adhere to the Supreme Court mandate for determining patentability; it interpreted the law in conflict with other decisions by the same court and by other federal courts. Thus, the jurisdiction of this Court is invoked.

STATUTE INVOLVED 35 USC §103

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior act

are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

STATEMENT OF THE CASE

This petition for Writ of Certiorari stems from a United States Court of Appeals for Federal Circuit's Decision affirming the Patent and Trademark Office's, specifically the examiner's and the Board of Appeals and Interferences', determination that the claims of U.S. Patent No. 4,128,458 [App. 1][1] issued December 5, 1978 to Joseph O. Obiaya are not patentable. The patent claims a combined combustibles and oxygen concentration analyzer.

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[1]The Appendix is in a separate volume; submitted evidence before the Court of Appeals. Citations to the Appendix designate the Appendix page by number.

In September, 1982, Mr. Obiaya sued the Babcock & Wilcox Company and codefendent Lubrizol Corporation for infringement of the patent in the U.S. District Court for the Northern District of Ohio (Civil Action No. C-82-1889) under 35 USC §§271 and 281. Jurisdiction was conferred upon that Court by 28 USC §1338(a). On September 26, 1983, pursuant to 35 USC §302-307, defendant Babcock & Wilcox requested reexamination of the patent [App. 17], which was granted. In the process of discovery, just at the time the petitioner, Mr. Obiaya, sought to depose those individuals (employees of Babcock & Wilcox) who failed in an earlier attempt to develop the invention, Babcock & Wilcox obtained a stay in proceedings in the District

Court, over the objections of petitioner, pending the reexamination outcome, by an order dated February 17, 1984 [Petition 44][2]. Babcock & Wilcox argued before Judge Lambros that Mr. Obiaya could rely on affidavits and declarations to prove his case. Judge Lambros thus noted in that order that:

> "Plaintiff will have the opportunity to present his position with respect to this prior art at the reexamination proceedings in the form of affidavits and declarations. 37 C.F.R. §§1.131-32. [Petition 50, 51]

In the reexamination determination the examiner issued a final rejection [App. 314] of all claims on October 19,

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[2]Appendix to this petition is in a separate accompanying volume. Citations designate the appendix number.

1984, relying on a combination of newly cited references. The rejection was affirmed by the Patent Office Board of Appeals and Intereferences on July 23, 1985 [App. 337] and by the Court of Appeals on May 30, 1986. The Court of Appeal's rejection under 35 USC 103 asserts that a combination of references brought to the attention of the Patent Office by the requester/defendant Babcock & Wilcox would suggest the invention to one of ordinary skill. [Petition 2, 3] (Note that the rejection was under 35 USC 103 and not under 101 or 102; the invention, therefore is significantly different from the prior arts and has advantages over them; the issue is limited to the obviousness or nonobviousness of it.)

The inventor/petitioner, Mr. Obiaya, however submitted factual evidence which directly rebuts the obviousness determination. The evidence [App. 188, 307] shows failed attempts by the requester, Babcock & Wilcox, to develop the invention even while armed with knowledge of the same prior arts references relied upon for the rejection of the primary claims. The principal prior art references (the OC, Heat Prover, Ross et al) were developed, marketed and assigned to Babcock & Wilcox. [App. 40, 60, 10]

A Babcock & Wilcox research team of three engineers and two senior technicians undertook the development work. The project was headed by one Thomas L. Bohl, a company senior project engineer [App. 189] and began as early

as 1975 as witnessed by Babcock & Wilcox report 8094 dated August 19, 1975 [App. 20]. The Babcock & Wilcox product which infringed Mr. Obiaya's invention was commercially introduced in 1981. Several designs were fabricated and extensively tested without success before Mr. Obiaya's solutions were adopted. [App. 188, 307] The failed designs lacked an essential component of the invention. Even though Babcock & Wilcox was familiar with this particular component and had used it in other products, they failed to recognized its usefulness in this invention; its use was not obvious to them. If for no other reason the invention should have been allowed on account of the nonobviousness of this component to Babcock & Wilcox. The provision in the

103 statute stipulates that the invention must be considered as a whole. While the Court of Appeals and the Patent and Trademark Office noted the unique advantageous application of this component, they still concluded that it would have been obvious.

The Court of Appeals and the Patent and Trademark Office rejected the evidence of failure by Babcock & Wilcox in their determination of obviousness. They determined obviousness wholly subjectively. Neither the Court of Appeals nor the Patent Office cited any precedent cases in support of their rejection of this evidence. However precedent cases and opinions of the courts exist in support of the use of failure by others in general.

ARGUMENT

I. Meaning of Skilled Artisan under 35 USC 103

The examiner's decision on the basis of 35 USC 103 that the Obiaya '458 patent would have been obvious to "a person having ordinary skill in the art" has been rebutted by evidence showing facts that existed at the time the invention was made. The evidence [App. 188, 307] shows that one skilled in the art, Babcock & Wilcox, did in fact attempt to develop the invention without success even though thoroughly knowledgeable concerning the same prior art references relied upon by the examiner. All the prior arts (the OC, Heat Prover and Ross et al patent) [App. 40, 60, 10] cited against the primary claims, Claims 1, 2, 3 14 were

developed, marketed and assigned to the same company, Babcock & Wilcox, that failed in an earlier attempt to develop the invention. The examiner held that the skilled artisan of 35 USC 103 refers exclusively to a phantom person and factual evidence relating to specific activities, persons and results is not relevant:

> Whether the invention is or is not obvious to a specific person [Babcock & Wilcox in this case] is not really germaine. The test is whether or not the invention would be obvious to one of ordinary skill in the art, that "one" not being any specific person or persons [Petition 33, 34]

The Board of Appeals and Inteferences adopted this interpretation [Petition 13] and the Court of Appeals found no error in the Board's rejection [Petition 2]

In the District Court decision of Studiengesellschart Kohle, m.b.h. v. Dart Industries, Inc., 549 Supp. 716, 216 USPQ 381 (D.C. Del., 1982) (Aff'd. 726 F.2d 724) the evidence indicated that a team of DuPont researchers who were familiar with the same prior art that allegedly rendered the invention obvious failed to produce the catalyst of the invention. The court found that:

> The efforts of the exploratory group do not demonstrate that Fischer and Hall and Nash or other prior art render Zibgler's '115 obvious. DuPont chemists read the Fischer patent early. Despite a major effort, involving many experienced scientists with high priority access to the resources of DuPont's experimental station, the DuPont group explored a number of alternatives before investigating Alkyl Aluminimums. If, as Dart argues, ethyl aluminum chlorides are "obviously" the mechanism of the Fischer patent one would expect DuPont

> to have looked into them more immediately." Id. at 735 and 394.

In the present case, not only was the Babcock & Wilcox research team aware of all the principal references (in contrast with the DuPont team which read only the Fischer Patent) but they also actually developed and marketed the prior art devices. Had the Obiaya invention been so obvious, why had not Babcock & Wilcox been led directly to the solution? Babcock & Wilcox had working (not merely theoretical) knowledge of the prior art references.

The examiner's interpretation of the skilled artisan of 35 USC 103 as a phantom person is clearly in error. The Court of Appeals and the Patent and Trademark Office determined obviousness to the skilled artisan wholly

subjectively and contrary to the factual evidence; yet the art of invention, after all, is generated by real people tackling real problems in real world settings.

II. The Scope of the Supreme Court Mandate of Graham v. Deere.

The Court of Appeals implied that it gave discretionary consideration to evidence of failure by Babcock & Wilcox:

> The requesters purported failure to produce the claimed invention is insufficient in this case to rebut the Board's prima facie case of obviousness [Petition 4]

The Court of Appeals implied by the foregoing that it gave "secondary consideration" to the evidence of failure by others in this case as mandated by the Supreme Court decision of Graham v. John Deere, 383 US 1, 86 S.

Ct. at 694, 148 USPQ 459 at 467 [8]. The circumstances of this case, however, require that it be given "primary consideration."

While the Supreme Court gave evidence of failure by others in the Deere decision "secondary consideration" to be used at the discretion of the court for tipping the scale of patentability, it should be emphasized that the court also noted the specific nature of the failure by others. The court made clear that those who failed in the Deere case, supra, had no prior knowledge of the prior art cited against the invention:

> ". . . no one apparently chose to avail themselves of knowledge stored in the Patent Office and readily available by the simple expedient of conducting a patent search." Id. at 703, 474.

Even though the Supreme Court stated in the use of that evidence that it is irrelevant that no one chose to avail themselves of knowledge through patent search, it did not say that it would have been irrelevant had knowledge of the prior art been acquired before the failed attempt. The differences in the nature of failure by others between the Deere case and the present case are, therefore, quite significant: the former offers incomplete answers while the latter provides complete answers for determining nonobviousness or obviousness.

When inquiry is made in both cases as to what a skilled artisan would have done who is armed with the referenced arts at the time of the invention, the answer provided by the Deere case is at

best inconclusive. In the instant case the answer is definite. With respect to the Deere case, the argument can be made that the result of the failed attempt might have been different had the individuals been armed with knowledge of all the prior art. It is safe to surmise therefrom that it is because of this gap in the Deere evidence that the Supreme Court gave it a "secondary consideration."

It is submitted that the preponderance of patent cases are in the Deere class, lacking the necessary evidence for determining obviousness or nonobviousness objectively. The extensive analysis in the Deere case, supra, (Id. at 691-694, 464-467) pertains to this class of cases and is a systematic attempt to standardize the

subjective determination process in a way that approximates objectivity. However the evidence of the failure of Babcock & Wilcox in this particular case permits absolute objectivity in the determination of nonobviousness. One can venture to say, therefore, that the Supreme Court did not consider the circumstances of this type of case because the determination of non-obviousness is self-evident from the 103 statute, and its occurence rare. The Supreme Court recognized the fallibility of human judgments and so cautioned, in the exercise of the discretion granted the courts in the Deere class (of secondary evidence), against the danger of slipping into hindsight and reading into prior art the teachings of the invention in issue.

Given these facts, the evidence of failure by Babcock & Wilcox to develop the invention should have been given "primary" and not "secondary" consideration as it is implied by the comment of the Court of Appeals. This assessment is in agreement with the opinion of the Court of Appeals in W.L. Gore & Associates v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1984):

> It is difficult but necessary that the decision maker forget what he or she has been taught at trial about the claimed invention and cast the mind back to the time the invention was made (often as here many years), to occupy the mind of the one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art. Id. at 1553, 313.

This "Litmus test" for patentability interpreted here by the Court of Appeals is directly applicable in the present

case. Babcock & Wilcox in reality is one such skilled artisan who was presented "with the references." Thus failure by Babcock & Wilcox deserves "primary consideration." Inasmuch as human judgments are not infallible it is submitted that actual facts are more cogent than an expert's opinion; yet the Court of Appeals and the Patent and Trademark Office ignored the failure of Babcock & Wilcox as not meeting the test of patentability.

The Supreme Court opined in Graham v. Deere, supra, that:

> The emphasis on nonobviousness is one of inquiry, not quality and as such comports with constitutional strictutures. Deere at 693[13], 467[7].

What better inquiry can there possibly be than the foregoing; it is direct and to the point.

The Court of Appeal's decision rests on the opinion that: "The prior art relied on by the Board is 'reasonably pertinent to the particular problem with which [Obiaya] was involved', In re Wood, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979) and was not improperly construed with the claimed invention in mind, In re Antle, 444 F.2d 1168, 1171, 170 USPQ 285, 287 (CCPA 1971)," [Petition 2, 3]

The pertinency of the prior arts is not at issue. The point of contention is the inference that was drawn from the cited prior arts and the manner by which that determination was made. The Court concluded that:

> Each element of Obiaya was contained in the prior art reference and their combination would have been

> suggested [to a skilled artisan] by those references [Petition 3].

Yet the Court of Appeals and the Patent and Trademark Office ignored the evidence, the failure of Babcock & Wilcox, which prove otherwise. Neither of the two referenced opinions, In re Wood, supra and In re Antle, supra, address this central issue.

The skill of Babcock & Wilcox research team is not in doubt. Thomas L. Bohl, the project leader, is a named inventor on ten U.S. Patents a copy of the description from the Patent Office Official Gazette for each of these patents is of record [Reply App. 5] to show they relate to the gas analyzer field. Each of these ten patents is assigned to the Babcock & Wilcox Company. Mr. Bohl's work on

these inventions in combination with his acknowledged engineering duties and experience (also of record [App. 293-295] establish Mr. Bohl as one of greater than ordinary skill in the gas analyzer field.

Mr. Edward William Fisher [App. 189], a research specialist and a member of the research group, is a named inventor of U.S. Patent No. 4,063,898 entitled "Combustibles Gases Detector" [App. 110] which was cited against Claim 5 of the Obiaya '458 patent.

Ms. Sharon L. Zimmerlin, an engineer, another member of the group [App. 193], is a named inventor of U.S. Patent No. 4,355,056 entitled "Method of Manufacturing A Combustibles Sensor."

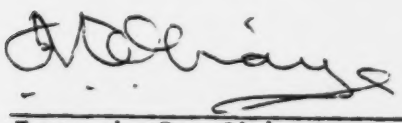
If the Obiaya '458 patent was not obvious to these individuals (members of

the research team), with priority access to Babcock & Wilcox wealth of information and with working knowledge of the referenced prior arts, then the argument is made that it was obvious to the Court of Appeals and the Patent and Trademark Office only from the vantage point of hindsight.

CONCLUSION

Because of the blatant misappliation of the law by the Court of Appeals, allowance of this petition is solicited.

Respectfully submitted,



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CERTIFICATE OF SERVICE

This is to certify 3 copies of the foregoing PETITION FOR WRIT OF CERTIORARI has been served by U.S. Air Mail, Postage Prepaid, on the Solicitor General, Department of Justice, Washington, D.C. 20530, and that 3 copies of the foregoing PETITION FOR WRIT OF CERTIORARI has been served by U.S. Air Mail, Postage Prepaid, on Thomas C. Tarolli, Esq., Yount & Tarolli, 1111 Leader Building, Cleveland, Ohio 44114, Attorney for Requester Babcock & Wilcox Company this 15th day of September, 1986.

Joseph O. Obiaya